

REMARKS

After entry of the present Amendment, claims 1, 3-5, 8-10, and 12 remain pending in the application. Claim 1 has been amended to include the elements of original claim 2. As such, original claim 2 has been cancelled. Previously presented claim 11 has also been cancelled. Claims 6 and 7 were previously withdrawn. After entry of the present Amendment, claims 6 and 7 remain withdrawn but are currently amended for dependency. That is, claims 6 and 7 now depend from claim 1, rather than from original claim 2 which has been cancelled. New claim 12 has been added to define a weight ratio of component (A) to component (B) when the number-average molecular weight of component (A) is 100,000 or more. Support for new claim 12 can be found in at least paragraph [0015] of United States Patent Application Publication No. 2006/0104929 A1 (the '929 publication). Thus, no new matter has been added through the present Amendment.

Claim Rejections Under 35 U.S.C. §112 and §101:

Claim 11 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Claim 11 also stands rejected under 35 U.S.C. §101 as an improper definition of a process. As set forth above, claim 11 has been cancelled. Therefore, the Applicants respectfully submit that the rejections of claim 11 are moot and respectfully request that the rejections be withdrawn.

Claim Rejections Under 35 U.S.C. §102(b):

Claims 1-5 stand rejected under 35 U.S.C. §102(b) as anticipated by United States Patent No. 6,013,682 to Dalle et al. (the '682 patent). In view of the amendment to claim 1 to incorporate the elements of claim 2, the Applicants respectfully submit that currently amended claim 1, and claims 3-5, 8-10, and 12 that depend from claim 1, are both novel and non-obvious over the prior art.

As the Examiner is aware, to anticipate a claim under 35 U.S.C. §102, a reference must teach every element of the claim (see MPEP §2131). Stated another way, "[t]he identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). For the reasons set forth below, the Applicants respectfully assert that the '682 patent does not teach every element of claim 1 as amended.

The Examiner contends that Examples 1-3 of the '682 patent prepare an aqueous emulsion using a polydimethylsiloxane terminated with dimethylvinylsiloxy groups (allegedly corresponding to component (A) of the present invention) and a liquid organohydrogenpolysiloxane having an average formula of $\text{Me}_2\text{HSiO}(\text{Me}_2\text{SiO})_{20}\text{SiMe}_2\text{H}$ (allegedly corresponding to component (B) of the present invention). The Examiner also contends that the liquid organohydrogenpolysiloxane of the '682 patent does not contain any hydrosilation-reactive groups. The Applicants respectfully disagree and assert that the '682 patent fails to anticipate claim 1, as amended, on the basis that the '682 patent fails to teach at least:

- 1) that component (B) does not contain hydrosilation-reactive groups,
- 2) that component (A) is a linear organosilicon polymer whose main chain is composed of diorganosiloxane units and alkylene units, and
- 3) that the weight ratio of component (A) to component (B) is 1:0.5 to 1:50.

In particular, with respect to component (B) of the present invention, the liquid organohydrogenpolysiloxane having the average formula of $\text{Me}_2\text{HSiO}(\text{Me}_2\text{SiO})_{20}\text{SiMe}_2\text{H}$ as specified in Examples 1-3 of the '682 patent (allegedly corresponding to component (B) of the present invention), **does** in fact contain hydrosilation-reactive groups that may exert influence on a hydrosilation reaction. More specifically, the liquid organohydrogenpolysiloxane of the '682 patent **contains at least two SiH groups**. In fact, the liquid organohydrogenpolysiloxane of Examples 1-3 contains "0.16 to 0.20% SiH" (column 7, line 55). Such SiH groups are clearly hydrosilation-reactive groups that may exert influence on a hydrosilation reaction. In fact, the '682 patent describes the hydrosilation reaction "in which an **Si-H** reacts with an aliphatically unsaturated group in the presence of a platinum or rhodium containing catalyst" (column 2, lines 31-33) or "the reaction of SiOH with an **SiH** in the presence of a metal containing catalyst" (column 2, lines 40-41) (emphasis added). Therefore, the Applicants respectfully assert that the '682 patent does not teach that component (B) does not contain hydrosilation-reactive groups. Thus, for at least the reasons set forth above, claim 1 as now amended with the element of original dependent claim 2 is not anticipated by the '682 patent.

Moreover, with respect to component (A) of the present invention, the Examiner contends that the polydimethylsiloxane terminated with dimethylvinylsiloxo groups of Examples 1-3 of the '682 patent anticipates component (A) of the present invention. The Applicants respectfully disagree. In particular, the '682 patent does not disclose a linear organosilicon polymer whose **main chain** is composed of diorganosiloxane units **and alkylene units**. Rather, the '682 patent discloses a dimethylvinylsiloxo **terminated** polydimethylsiloxane (column 7, line 50) (emphasis added). That is, the '682 patent does not disclose an organosilicon polymer wherein both ends of each alkylene unit are bonded to silicon atoms of adjacent diorganosiloxane units. Therefore, the Applicants respectfully assert that the '682 patent does not teach that component (A) is a linear organosilicon polymer whose main chain is composed of diorganosiloxane units and alkylene units. Thus, for at least the reasons set forth above, claim 1 is not anticipated by the '682 patent.

Finally, with respect to the weight ratio of component (A) to component (B), the Examiner contends that the ratio of component (A) to component (B) in Examples 1-3 of the '682 patent are 1:0.03, 1:0.03, and 1:0.06 respectively. The Applicants respectfully submit that the weight ratio for Example 3 of the '682 patent is 1:0.04, i.e., 1.15 parts of the organohydrogenpolysiloxane / 29 parts of the dimethylvinylsiloxo terminated polydimethylsiloxane. Therefore, the Applicants respectfully assert that the '682 patent does not teach that the weight ratio of component (A) to component (B) is 1:0.5 to 1:50. Thus, for at least the reasons set forth above, claim 1 as now amended is not anticipated by the '682 patent.

Claim Rejections Under 35 U.S.C. §103(a):

Claims 1, 4, and 8-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the '682 patent. In light of both the arguments set forth above to traverse the anticipation rejection of claims 1-5 and the cancellation of claim 11 through the present Amendment, the Applicants respectfully submit that the rejections of claims 1, 4, and 11 under §103(a) have become moot. That is, there is no teaching in the prior art for component (B) to not contain hydrosilation-reactive groups, as set forth in currently amended claim 1, and therefore, the aqueous emulsion of currently amended claim 1 would not have been obvious to a skilled artisan. Further, since claims 8-10 depend from currently amended claim 1, the Applicants respectfully submit that the rejections of claims 8-10 have also become moot. Therefore, the Applicants respectfully request that the rejections of claims 1, 4, and 8-11 be withdrawn.

In view of the foregoing, the Applicants respectfully submit that the currently amended claim 1, as well as claims 3-5, 8-10, and 12 that depend from claim 1, are both novel and non-obvious over the prior art including over the '682 patent. As such, the Applicants submit that the claims are now in condition for allowance and respectfully request such allowance. Importantly, based on the arguments set forth above and per MPEP §706.07, in the event of further examination of claim 1 that has been currently amended to include the elements of novel and non-obvious claim 2, the Applicants respectfully remind the Examiner that the Examiner must provide the Applicants with an opportunity to respond since the current amendment of

claim 1 does not introduce new subject matter that was not previously claimed. That is, any further examination of claim 1 must not be made final.

This response is timely filed; thus, it is believed that no further fees are presently due. However, if necessary, the Commissioner is authorized to charge Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys, P.C. for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS

August 28, 2008
Date

/David M. LaPrairie/
David M. LaPrairie, Registration No. 46,295
Howard and Howard Attorneys, P.C.
The Pinehurst Office Center, Suite 101
39400 Woodward Ave.
Bloomfield Hills, MI 48304-5151
(248) 723-0442